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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,311	06/19/2001	Steven B. Adler	AUS920010589US1	6894

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Walder Intellectual Property Law (END)
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EXAMINER

ARMOUCHE, HADI S

ART UNIT	PAPER NUMBER
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2432

MAIL DATE	DELIVERY MODE
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06/14/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/884,311	Applicant(s) ADLER ET AL.	
	Examiner HADI ARMOUCHE	Art Unit 2432	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 19 and 23-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 19 and 23-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09/10/2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/16/09 & 06/08/10</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicant's amendment filed on 03/16/2010. Claims 1, 3, 27 and 33 have been amended; claims 39-40 have been added. Claims 1-3, 19 and 23-40 remain pending.
2. Applicant is kindly reminded and is requested that upon any claim amendment to show the examiner where in the original disclosure the amendment is being supported. See MPEP 714.02 and 2163.06 ("Applicant should specifically point out the support for any amendments made to the disclosure"). Applicant has not indicated where the newly added limitations are supported in the original disclosure.

Response to Arguments

3. Acknowledgment to applicant's amendment to the abstract has been noted. The abstract has been reviewed, entered and found obviating to previously raised objection to the abstract for exceeding 150 words and for using legal phraseology. Objection to the abstract is hereby withdrawn.
4. Acknowledgment to applicant's amendment to the specification has been noted. The specification has been reviewed, entered and found obviating to previously raised objection to the specification for containing an embedded hyperlink and/or other form of browser-executable code. Objection to the specification is hereby withdrawn.
5. Applicant's amendment to claims 1, 27 and 33 obviates previously raised claim rejection under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Rejection to claims 1, 27 and 33 under 35 U.S.C 112 is hereby withdrawn.

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6. Applicant's arguments with respect to the 35 U.S.C 101 rejection to claims 33-38 have been fully considered but they are not persuasive.

7. It has been argued (page 12 of the remarks) that adding the limitation "storage" to the computer-useable medium" directs the claims 33-38 to a statutory subject matter.

8. Examiner respectfully disagrees. The specification does not explicitly define what is meant by "storage medium". The specification page 7 line 29-page 8 line 3 states:

"Computer-usable medium" means any carrier wave, signal or transmission facility for communication with computers, and any kind of computer memory, such as floppy disks, hard disks, Random Access Memory (RAM), Read Only Memory (ROM), CD-ROM, flash ROM, non-volatile ROM, and non-volatile memory.

"any kind" and "such as" are an open ended limitation and does not exclude non-statutory subject matter. It is suggested to add the limitation "non-transitory" before "computer-usable medium" to overcome the 35 U.S.C 101 set forth below.

9. It has been argued (page 15 of the remarks) that King does not teach that the agreement between the parties is tied to the sensitive information that is being communicated.

10. Applicant's interpretation of the reference is noted. However, examiner respectfully disagrees. King in col 3 lines 37-38

computer program code for negotiating a privacy agreement that governs the exchange of the private information

Later in col 11 (in particular line 36) teaches a sample of an accepted privacy agreement which include a limitation of which information may be transmitted to.

See also col 12 lines 22-24.

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11. It has been argued (page 16 of the remarks) that King does not define if and how the proxy server is able to provide the sensitive data.

12. Applicant's interpretation of the reference is noted. However, examiner respectfully disagrees. King in col 9 lines 37-45 teaches:

Privacy manager 228 manages preexisting privacy agreements and acts as a negotiating agent in establishing new privacy agreements between wireless client devices and server devices. In its capacity as negotiating agent, privacy manager 228 may generate user interfaces for the participants (e.g., an HDML user interface for the wireless client devices) which define the information covered by the agreement, the term of the agreement (e.g., expiration date/time) and how that information may be used. Once a privacy agreement has been established between server devices and proxy server device 208, the requested private data can be supplied to the requesting server device in accordance with the terms and conditions of the privacy agreement. For purposes of optimizing the process, the wireless client device and proxy server device 208 can establish a standing agreement, which pre-establishes terms and conditions for the release of location and related information.

Later in col 14 lines 35-37, King teaches:

The proposed privacy agreement is a proposed agreement in which the content server specifies how private data is to be used by the content server.

13. Applicant's arguments (pages 16-17 of the remarks) with respect to newly added limitation of "*object is of an object model in an object oriented programming language.*" have been considered but are moot in view of the new ground(s) of rejection.

14. It has been argued (pages 18-19 of the remarks) that King does not teach the newly added limitation of claim 3 and that Tolopka does not teach an object class representing a filled paper form.

15. Applicant's interpretation of the reference is noted. However, examiner respectfully disagrees. The rejection was structured so that the three references (King,

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Miller and Tolopka) would be taken in combination. King throughout the specification and summarized in col 2 lines 55-65 teaches that the sever and the proxy server negotiate a privacy agreement to exchange the client's information; wherein the proxy server makes sure that the negotiated privacy agreement is in compliant with the privacy agreement between the client and the proxy sever before the proxy sever exchange the information with the server. However, King does not teach that an object class representing a filled paper form. Miller teaches that the object is an object class of object oriented language (paragraphs 43, 125 and 247). Tolopka in column 6, lines 36-52 teaches that the "information" may represent a paper filled form. At the time of the invention, it would have been obvious to modify the combined teachings of King and Miller by Tolopka's teachings. The motivation/suggestion would have been to have a convenient manner of obtaining personal information and populating as an object

16. It has been argued (pages 20-23 of the remarks) that Gifford does not teach transforming the personal information into depersonalized format prior to exchanging the information in a reversible manner and transforming the personal information into an anonymized format prior to exchanging the information.

17. Applicant's interpretation of the reference is noted. However, examiner respectfully disagrees. The rejection was structured so that the three references (King, Miller and Gifford) would be taken in combination. The Gifford reference teaches protection of confidential information in a database. Column 8, lines 1-8, teaches a method where the correlation between public attributes and private attributes are reduced by camouflaging or outright removing some data. It would have been obvious

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to one of ordinary skill in the art at the time the invention was made to have the data in the object groups in King be depersonalized, i.e. camouflaged or removed, as taught in Gifford in order to protect confidential information from being inferred from a database, see column 4, lines 17-68.

18. Applicant is encouraged to schedule an interview with the examiner prior to the next communication to compact prosecution of the case.

Claim Rejections - 35 USC § 101

19. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

20. Claims 33-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a computer program product comprising a computer-usable medium. The specification page 7 line 29 defines the computer-usable medium as "any carrier wave, signal or transmission facility for communication". Carrier wave and signal are non-statutory subject matter. Applicant's amendment by adding the limitation "storage" does not overcome the 35 U.S.C 101 because the specification does not define explicitly what does the "storage medium" encompasses. It is suggested to add the limitation "non-transitory" before "computer-usable medium" to overcome the 35 U.S.C 101 set forth.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claims 1-2, 23-24, 27, 29-30, 33 and 35-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over King (US 7,093,286) in view of Miller et al. (US 2001/0054067) referred to hereinafter by Miller.

23. Regarding claims 1, 27 and 33, King teaches *an information handling system* [col 2 lines 43-46] *for handling personally identifiable information* [abstract], *said system comprising:*

a processor [col 8 line 55]; *and*

a memory coupled to the processor [col 2 lines 43-46 and col 8 line 55], *wherein the memory comprises instructions which, when executed by the processor, cause the processor to:*

provide a first set of object classes (network servers) representing active entities in an information- handling process [network servers: col 3 lines 15-16, col 4 lines 9-11 and figure 1 element 120] ;

provide a second object class (client devices/subscriber) representing personally identifiable information [sensitive information: col 3 lines 37-38, col 5 lines 4-10, col 5 lines 28-31, col 9 lines 44-53] *and associated rules in said information-handling process* [client devices/subscriber: col 3 lines 15-16, col 4 lines 9-11 and figure 1 element 100] ;
and

process transactions involving said personally identifiable information, using said first set of object classes and said second object class, so as to enforce a privacy policy

[privacy agreement: col 3 lines 26-31 and abstract], *wherein said rules define if and how said personally identifiable information is provided, by a first data user that previously requested the personally identifiable information from an active entity that is personally identifiable by the personally identifiable information, to a second data user that requests said personally identifiable information from the first data user* [col 3 lines 15-30, col 5 lines 45-49, col 6 lines 50-65, col 7 lines 24-27, col 9 lines 37-45, ol 14 lines 35-37 and figure 1].

Even though King teaches that the system can be implemented on a computer readable medium including computer program code [col 2 lines 43-46 and col 3 lines 55-56], King does not explicitly teach that the object is *of an object model in an object oriented programming language*. Miller teaches providing customized experience to the web users by collecting personally identifiable information. The system is executed on a computer using JAVA or any object oriented programming [paragraphs 43, 125 and 247].

At the time of the invention was made, it would have been obvious to an ordinary skill in the art to modify King's system of indicating that the object are of object model in an object oriented programming language as taught in Miller. The motivation/suggestion would have been to execute the system on a computer readable medium including computer program code [King: col 2 lines 43-46 and col 3 lines 55-56].

24. Regarding claim 2, King teaches that the *first set of object classes includes a data user object class* [network servers: col 3 lines 15-16, col 4 lines 9-11 and figure 1 element 120].

25. Regarding claims 23, 29 and 35, King teaches that the *privacy policy is associated with the personally identifiable information and defined by said rules, and is enforced against one or more active entities represented by said first set of object classes* [col 3 lines 15-30, col 5 lines 45-49, col 6 lines 50-65, col 7 lines 24-27, and abstract], *and wherein each of the one or more active entities represented by said first set of object classes is a legal entity* [col 11 lines 40-41].

26. Regarding claims 24, 30 and 36, King teaches *a first active entity represented by a first object class in said first set of object classes is said first data user that previously requested said personally identifiable information from said data subject that is a second active entity represented by a second object class in said first set of object classes* [network servers: col 3 lines 15-16, col 4 lines 9-11, col 3 lines 15-30, col 5 lines 45-49, col 6 lines 50-65, col 7 lines 24-27 and figure 1 element 120], *and a third active entity [proxy server] represented by a third object class in said first set of object classes is said second data user that requests said personally identifiable information from said first data user* [abstract and col 3 lines 15-31].

27. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Miller and in further in view of Tolopka et al. (US 6,044,349) referred to hereinafter by Tolopka .

28. Regarding claim 3, King teaches that the *second object class, having said rules associated with said data* (client devices/subscriber: col 3 lines 15-16, col 4 lines 9-11 and figure 1 element 100), *including both collected data, collected from the active entity*

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and including the personally identifiable information (col 3 lines 37-38, col 5 lines 4-10, col 5 lines 28-31, col 9 lines 44-53), and rules regarding said collected data specifying if and how the collected data is provided to the second data user, wherein the second data user sends an empty form including a policy to the first data user requesting the personally identifiable information, and wherein the first data user checks the policy included with the empty form to determine if disclosure of the personally identifiable information is permitted based on the policy included with the empty form and the rules regarding the collected data (col 2 lines 58-60). The combined teachings of King and Miller do not disclose an object class representing a filled paper form. The secondary reference Tolopka teaches a storage medium for storing personal information that is subject to access control for apportion the data among authorized entities. Figure 2 shows various types of information and options for authorizing access to different groups. The information may represent a paper filled form, see column 6, lines 36-52. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the objects in King represent paper filled forms as taught in Tolopka as a convenient manner of obtaining personal information and populating as an object, see column 6, lines 36-52.

29. Claims 19, 25-26, 28, 31-32, 34 and 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over King in view of Miller and in further in view of Gifford et al (US 5,614,927) referred to hereinafter by Gifford.

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30. Regarding claims 19, 25-26, 28, 31-32, 34 and 37-40, the combined teachings of King and Miller do not disclose transforming the personal information into a depersonalized/ anonymized format. The Gifford reference teaches protection of confidential information in a database. Column 8, lines 1-8, teaches a method where the correlation between public attributes and private attributes are reduced by camouflaging or outright removing some data to depersonalize the identifiable information based on rules. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the data in the object groups in King be depersonalized, i.e. camouflaged or removed, as taught in Gifford in order to protect confidential information from being inferred from a database, see column 4, lines 17-68.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to HADI ARMOUCHE whose telephone number is (571)270-3618. The examiner can normally be reached on M-Th 7:30-5:00 and Fridays half day.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/H. A./
HADI ARMOUCHE
Examiner, Art Unit 2432

/Benjamin E Lanier/
Primary Examiner, Art Unit 2432